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EXAMINER

BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
2134	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/483,183	Applicant(s) TRETTER ET AL.	
	Examiner Christopher J. Brown	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/20/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 1/20/06, with respect to USC 112 1st rejection of claim 30 has been fully considered and are persuasive. The rejection of claim 30 has been withdrawn.

Read in its broadest reasonable interpretation, the "at the time of document distribution" could be any time relatively close to the actual time of document distribution. The instant specification does show establishing identity around the time of document distribution.

Applicant's arguments, filed 1/20/06, with respect to USC 112 2nd rejections of claims 12, 26, and 27 have been fully considered and are persuasive. The rejections of claims 12, 26, 27 have been withdrawn.

Applicant's arguments filed 1/20/06 have been fully considered but they are not persuasive.

With respect to USC 112 1st rejection of claim 1, the specification does not support "the printer not having the identity until the identity is given". The examiner is not arguing that there is no support for the smart card giving an identity. The examiner is arguing that there is nothing in the specification that prevents someone or something giving the identity to the printer *before* the smart card does.

Applicant's arguments with respect to claims 1, 12, 19 have been considered but are moot in view of the new ground(s) of rejection. The applicant's arguments in view of Debry US 6,385,728 are moot in view of the new grounds of rejection which do not include the Debry reference.

Applicant's arguments filed 1/20/06 have been fully considered but they are not persuasive.

As per claim 11, the applicant argues that Furman US 5,483,653 and Boyles US 6,738,901 do not teach charging for jobs that were actually printed. The applicant argues that Furman does not show a status screen. The examiner argues that Furman does show a status screen (resulting display) in Col 4 lines 24 of Furman. However this is a moot point as no status screen is actually claimed. However the examiner points out that it is inherent that the printer communicate with the server, otherwise the server would have no way of telling if the job was printed. Furman clearly illustrates that the display will indicate whether the job was printed. The applicant further argues that Boyle does not teach a server that charges for copies printed. The examiner again argues that it is inherent that the printer or copier communicate with the server, in this case to indicate the number of copies made, and thus incurring expenses. It is to be assumed in all cases, that

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the invention, or device, works properly. In the case when the device working properly copies made, or pages printed will be the “actual” number of copies.

The applicant makes special note that neither Boyles or Furman teaches a “document server” but a “document server” is not claimed.

As per the applicant’s argument with respect to claims 18 and 24, the examiner apologizes for any confusion in the rejection of the claims. Prior art to overcome claims 18 and 24 has been found which makes the previously allowable claims, unallowable in their current form.

Please see below for rejection of all other claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claim 1, support for the recitation of “the printer not having the identity unit the identity is given” cannot be found in the instant specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 5, 9, 10, 19, 23, 26, 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411

As per claims 1, 3, 19, 30, Kurachi teaches having a printer send its cryptographic key thus establishing its identity with the server, (Col 13 line 63-Col 14 line 3). Kurachi teaches that the printer receives an encrypted document from the network, (Col 14 lines 47-54). Kurachi teaches that the printer decrypts the document, (Col 14 line 51).

Kurachi teaches using the printer to print the document, (Col 15 lines 38-40).

Kurachi fails to teach that a smart card gives the identity to the printer.

Anvret teaches using a smart card to send identity and a key to a printer (facsimile), (Col 1 lines 54-57, Col 2 lines 5-8, Col 4 lines 25-30).

It would have been obvious to one of ordinary skill in the art to use the smart card system of Anvert with the printing system of Kurachi because the smart card allows keys to be stored in a locally safe manner (Anvert Col 6 lines 35-37).

As per claim 4 Kurachi does not disclose a smart card.

Anvert teaches using a smart card to perform all calculations including decryption, (Col 6 lines 3-8, Col 7 lines 16-24).

It would have been obvious to one of ordinary skill in the art to use the decryption on smart cards of Anvert with the printer system of Kurachi because protection of equipment can only be guaranteed in the card reader, (Anvert Col 7 lines 12-15).

As per claim 5, Kurachi teaches an embedded processor, (Col 7 line 66). Kurachi teaches decrypting the document at the printer, (Col 15 lines 29-31).

As per claim 9, Kurachi teaches key exchange prior to ordering a document, but does not explicitly state authentication.

Anvert teaches that an authentication procedure takes place using the smart card, (Col 5 lines 53-64).

It would have been obvious to one of ordinary skill in the art to to use authentication with the print system of Kurachi because it increases the security of the system.

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As per claim 10, 23 Kurachi teaches using the printer to print (render) the document, (Col 15 lines 38-40).

As per claims 26, and 29 Kurachi teaches having a printer send its cryptographic key system to establishing its identity with the server, (Col 13 line 63-Col 14 line 3, Col 16 lines 55-60

Kurachi fails to teach that a smart card gives the identity to the printer. Kurachi fails to teach a token system.

Anvret teaches using a smart card to send identity and a key to a printer (facsimile), (Col 1 lines 54-57, Col 2 lines 5-8, Col 4 lines 25-30). Anvert teaches using a smart card to perform all calculations including decryption, (Col 6 lines 3-8, Col 7 lines 16-24).

Anvret fails to teach a token system.

It would have been obvious to one of ordinary skill in the art to use the smart card system of Anvret with the printing system of Kurachi because the smart card allows keys to be stored in a locally safe manner (Anvert Col 6 lines 35-37).

Davis teaches a method of authentication comprising a first agent encrypting a token and sending it to a second agent wherein the second agent decrypted the token. The second agent encrypts the “decrypted token” with a key and sends it back to the first agent for comparison, (Col 8 lines 33-47).

It would have been obvious to one of ordinary skill in the art to modify the print system of Kurachi-Anvret with the authentication system of Davis because it assures both agents are authentic and communications are secure.

Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Furman US 5,483,653.

As per claims 2, and 22 the previous Kurachi-Anvret combination does not teach a number of copies to be printed.

Furman discloses a message send with a document (job ticket) that indicates the number of copies to be printed, where the printer prints the number of document copies indicated in the message, (Col 6 lines 26-31, Col 7 lines 7-12, 32-35, Fig 3).

It would be obvious to modify the previous Kurachi-Anvret combinations encryption of documents with Furman's printer instructions because it provides the printer with needed instruction.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Mazzagatte US 6,862,583

As per claim 6, the previous Kurachi-Anvret system does not teach ordering a document prior to establishing printer identity.

Mazzagatte teaches the first step is ordering a document which occurs prior to establishing printer identity, (Col 7 lines 35-40).

It would have been obvious to one of ordinary skill in the art to use the order of Mazzagatte with the print system of Kurachi-Anvret because it allows printing only at a printer where one has a smart card, (Mazzagatte Col 2 lines 30-35).

Claims 7, 8, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Peairs US 5,717,940.

As per claims 7, and 20 the previous Kurachi-Anvret combination does not disclose that the printer is used to order the document.

Peairs discloses that the printer may be used to order the document, (Col 3 lines 10-23).

It would be obvious for one skilled in the art to modify the previous Kurachi-Anvret combination print system, with de Peairs ordering system because it would allow a user to retrieve a document from any global location.

As per claim 8, the previous Kurachi-Anvret combination combination does not disclose previewing at least one low quality document before ordering.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27, 57-59).

It would be obvious for one skilled in the art to modify the previous Kurachi-Anvret combination print system, with de Peairs preview system because seeing a preview allows a user to easily select the document they are seeking.

Claims 11, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Furman US 5,483,653 in view of Boyles's US 6,738,901

As per claims 11, and 21, Kurachi teaches having a printer send its cryptographic key thus establishing its identity with the server, (Col 13 line 63-Col 14 line 3). Kurachi teaches that the printer receives an encrypted document from the network, (Col 14 lines 47-54). Kurachi teaches that the printer decrypts the document, (Col 14 line 51).

Kurachi teaches using the printer to print the document, (Col 15 lines 38-40).

Kurachi fails to teach that a smart card gives the identity to the printer.

Anvret teaches using a smart card to send identity and a key to a printer (facsimile), (Col 1 lines 54-57, Col 2 lines 5-8, Col 4 lines 25-30).

It would have been obvious to one of ordinary skill in the art to use the smart card system of Anvret with the printing system of Kurachi because the smart card allows keys to be stored in a locally safe manner (Anvert Col 6 lines 35-37).

Furman discloses that the user can determine the status of printing through the server, (Col 4 lines 20-24).

It would be obvious to modify the previous Kurachi-Anvret combination print system with Furman's status screen because it provides lets the user know when his print jobs are complete.

Boyles teaches a network printer that registers a cost with a server for every copy printed, (Col 9 lines 18-21).

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It would have been obvious for one of ordinary skill in the art to modify the previous Kurachi-Anvret-Furman combination with Boyles charging, because it allows for a more versatile economic model for DRM.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Furman US 5,483,653 in view of Boyles's US 6,738,901 in view of Davis US 5,568,552.

As per claim 27, Kurachi teaches having a printer send its cryptographic key system to establishing its identity with the server, (Col 13 line 63-Col 14 line 3, Col 16 lines 55-60 Kurachi fails to teach that a smart card gives the identity to the printer. Kurachi fails to teach a token system.

Anvret teaches using a smart card to send identity and a key to a printer (facsimile), (Col 1 lines 54-57, Col 2 lines 5-8, Col 4 lines 25-30). Anvert teaches using a smart card to perform all calculations including decryption, (Col 6 lines 3-8, Col 7 lines 16-24).

Anvret fails to teach a token system.

It would have been obvious to one of ordinary skill in the art to use the smart card system of Anvret with the printing system of Kurachi because the smart card allows keys to be stored in a locally safe manner (Anvert Col 6 lines 35-37).

Davis teaches a method of authentication comprising a first agent encrypting a token and sending it to a second agent wherein the second agent decrypted the token. The second

agent encrypts the “decrypted token” with a key and sends it back to the first agent for comparison, (Col 8 lines 33-47).

It would have been obvious to one of ordinary skill in the art to modify the print system of Kurachi-Anvret with the authentication system of Davis because it assures both agents are authentic and communications are secure.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Furman US 5,483,653 in view of Boyles’s US 6,738,901.

As per claims 22 the previous Kurachi-Anvret-Boyles combination does not teach a number of copies to be printed.

Furman discloses a message send with a document (job ticket) that indicates the number of copies to be printed, where the printer prints the number of document copies indicated in the message, (Col 6 lines 26-31, Col 7 lines 7-12, 32-35, Fig 3).

It would be obvious to modify the previous Kurachi-Anvret-Boyles combinations encryption of documents with Furman’s printer instructions because it provides the printer with needed instruction.

Claims 18, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Davis US 5,568,552.

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As per claims 18, and 25, Kurachi teaches having a printer send its cryptographic key system to establishing its identity with the server, (Col 13 line 63-Col 14 line 3, Col 16 lines 55-60)

Kurachi fails to teach that a smart card gives the identity to the printer. Kurachi fails to teach a token system.

Anvret teaches using a smart card to send identity and a key to a printer (facsimile), (Col 1 lines 54-57, Col 2 lines 5-8, Col 4 lines 25-30). Anvret teaches using a smart card to perform all calculations including decryption, (Col 6 lines 3-8, Col 7 lines 16-24).

Anvret fails to teach a token system.

It would have been obvious to one of ordinary skill in the art to use the smart card system of Anvret with the printing system of Kurachi because the smart card allows keys to be stored in a locally safe manner (Anvret Col 6 lines 35-37).

Davis teaches a method of authentication comprising a first agent encrypting a token and sending it to a second agent wherein the second agent decrypted the token. The second agent encrypts the “decrypted token” with a key and sends it back to the first agent for comparison, (Col 8 lines 33-47).

It would have been obvious to one of ordinary skill in the art to modify the print system of Kurachi-Anvret with the authentication system of Davis because it assures both agents are authentic and communications are secure.

As per claim 24, Kurachi teaches that the printer receives an encrypted document from the network, (Col 14 lines 47-54). Kurachi teaches that the printer decrypts the document, (Col 14 line 51). Kurachi teaches using the printer to print the document, (Col 15 lines 38-40).

Claims 12, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte US 6,862,583 in view of Kurachi US 6,181,436 in view of Anvret US 5,307,411

As per claim 12, Mazzagatte teaches a server connected to the network, the documents being stored on said server, (Col 9 lines 7-10). Mazzagatte teaches the server sending at least one encrypted document to the printer after the document order has been placed, (Col 11 lines 45-60). Mazzagatte teaches the printer retrieving the document and printing the document, (Col 11 lines 55-60). Mazzagatte teaches a user presenting a smart card to a printer after the document order has been placed, and before the encrypted document is sent to the printer, (Col 9 lines 55-65). Mazzagatte fails to teach using the smart card to establish an identity between the printer and server.

Kurachi teaches having a printer send its public cryptographic key thus establishing its identity with the server, (Col 13 line 63-Col 14 line 3).

It would have been obvious to one of ordinary skill in the art to use the identity establishment of Kurachi with the print system of Mazzagatte because the identity

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establishment allows the server to encrypt data that only the printer will be able to decrypt.

Anvret teaches using a smart card to send identity and a key to a printer (facsimile), (Col 1 lines 54-57, Col 2 lines 5-8, Col 4 lines 25-30).

It would have been obvious to one of ordinary skill in the art to use the smart card system of Anvret with the printing system of Kurachi because the smart card allows keys to be stored in a locally safe manner (Anvert Col 6 lines 35-37).

As per claim 13 Mazzagattte teaches using a client to place a document order, (Col 7 lines 45-50).

As per claim 15, Mazzagatte does not teach decryption on a smart card.

Kurachi does not disclose a smart card.

Anvert teaches using a smart card to perform all calculations including decryption, (Col 6 lines 3-8, Col 7 lines 16-24).

It would have been obvious to one of ordinary skill in the art to use the decryption on smart cards of Anvert with the printer system of Mazzagatte-Kurachi because protection of equipment can only be guaranteed in the card reader, (Anvert Col 7 lines 12-15).

As per claim 16, Mazzagatte teaches decryption at the printer, (Col 11 lines 54-60).

Kurachi teaches having a printer send its public cryptographic key thus establishing its identity with the server, (Col 13 line 63-Col 14 line 3).

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It would have been obvious to one of ordinary skill in the art to use the identity establishment of Kurachi with the print system of Mazzagatte because the identity establishment allows the server to encrypt data that only the printer will be able to decrypt.

Anvret teaches using a smart card to send identity and a key to a printer (facsimile), (Col 1 lines 54-57, Col 2 lines 5-8, Col 4 lines 25-30).

It would have been obvious to one of ordinary skill in the art to use the smart card system of Anvret with the printing system of Kurachi because the smart card allows keys to be stored in a locally safe manner (Anvert Col 6 lines 35-37).

Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte US 6,862,583 in view of Kurachi US 6,181,436 in view of Anvret US 5,307,411 in vie of Peairs US 5,717,940

As per claim 14, the previous Mazzagatte-Kurachi-Anvret system does not teach a server that stores low quality previews.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27, 57-59).

It would be obvious for one skilled in the art to modify the previous Mazzagatte-Kurachi-Anvret combination print system, with de Peairs preview system because seeing a preview allows a user to easily select the document they are seeking.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte US 6,862,583 in view of Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Furman US 5,483,653 in view of Boyles's US 6,738,901

As per claims 17, the previous Mazzagatte-Kurachi-Anvret combination does not teach charging for copies.

Furman discloses that the user can determine the status of printing through the server, (Col 4 lines 20-24).

It would be obvious to modify the previous Kurachi-Anvret combination print system with Furman's status screen because it provides lets the user know when his print jobs are complete.

Boyles teaches a network printer that registers a cost with a server for every copy printed, (Col 9 lines 18-21).

It would have been obvious for one of ordinary skill in the art to modify the previous Mazzagatte-Kurachi-Anvret-Furman combination with Boyles charging, because it allows for a more versatile economic model for DRM.

Claim 28, is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte US 6,862,583 in view of Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Davis US 5,568,552.

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As per claim 28 The previous Mazzagatte-Kurachi-Anvert combination does not teach a token system.

Davis teaches a method of authentication comprising a first agent encrypting a token and sending it to a second agent wherein the second agent decrypted the token. The second agent encrypts the “decrypted token” with a key and sends it back to the first agent for comparison, (Col 8 lines 33-47).

It would have been obvious to one of ordinary skill in the art to modify the print system of Mazzagatte-Kurachi-Anvret with the authentication system of Davis because it assures both agents are authentic and communications are secure.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte US 6,862,583 in view of Kurachi US 6,181,436 in view of Anvret US 5,307,411 in view of Savage US 6,442,687.

As per claim 31, The previous Mazzagatte-Kurachi-Anvret combination does not teach a timeout period.

Savage teaches that if a response is not received within a specific period of time, communications are terminated, (Col 8 lines 26-32).

It would have been obvious to one of ordinary skill in the art to modify the Mazzagatte-Kurachi-Anvret combination print system with the timeout method of Savage because the timeout decreases the threat of a security breach.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matsui US 6,167,514 teaches a printer system including a smartcard exchange of keys and decryption.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Brown whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jaques Louis Jaques can be reached on (571)272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher J. Brown

4/14/06

